

## REMARKS

In accordance with the foregoing, the specification and claim 1, 2, 7, 8, 13, 14, 16, 17 and 18 have been amended. Claims 1-2, 4-8, 10-14 and 16-18 are pending and under consideration. Claims 1, 2, 7, 8, 13 and 14 are the independent claims.

Support for the amendments can be found in the specification as filed at least at page 15, lines 20-25. No new matter is believed to have been added.

**I. CLAIMS 1, 2, 4-8, 10-14, AND 16-18 ARE REJECTED UNDER 35 USC §103 AS BEING UNPATENTABLE OVER HARA ("HARA" US PAT. NO. 5,938,725) IN VIEW OF BIRRELL ET AL. ("BIRRELL" US PAT. NO. 6,189,026).**

The rejection to the claims under 35 USC §103 is respectfully traversed.

Hara discusses a method and apparatus for determining a destination address of an electronic mail message from stored electronic mail messages. In the Hara system, electronic mail (or e-mail) is stored and when a keyword is input, an e-mail including this keyword is retrieved from storage. An e-mail address included in the retrieved e-mail is extracted as an e-mail address of a transmission destination candidate, allowing the user to select the destination e-mail address from a list of candidate destination e-mail addresses.

Birrell discusses dynamically generating an address book in a distributed electronic mail (or e-mail) system. In the Birrell system, an address book is dynamically generated in a distributed mail service system, and mail messages are parsed and indexed to generate a full-text index.

The combination of Hara and Birrell is an apparatus for determining a destination address of an electronic mail message from stored electronic mail messages, and arranging the destination addresses in an address book for selection by a user.

The Examiner admits that Hara does not disclose an extracting unit, which extracts an email address from the text of an email message when the reply destination address corresponds to a mailing list. (Action at page 4). The Examiner asserts that Birrell provides this limitation of the claimed invention.

In contrast to the cited references, each of the independent claims 1, 2, 7, 8, 13 and 14 recites an automatic extracting unit (using claim 2 by way of example), "a first extracting unit which automatically extracts a reply destination mail address from a mail header of an E-mail received; a second extracting unit which automatically extracts at least one mail address

contained in a text of the E-mail received...and wherein the second extracting unit ...  
automatically extracts the at least one mail address."

As a further example, claim 7 recites a method of, "extracting automatically, when the reply destination mail address is the address of the mailing list, at least one mail address contained in a text of the E-mail received."

In contrast, Birrell discusses, "address information can be selected from a prior received mail message 805 by **clicking** on appropriate fields in the header or body of the message 805." (Birrell c. 10, lines 45-48, (emphasis added)). Such an arrangement requires the user to take an affirmative action in order for the address information to be selected from a received mail message, thus teaching away from the present invention. No automatic extracting unit is discussed in Birrell. Otherwise, Birrell provides that an address book is generated by "using a form 800 supplied by one of the client mail application programs." (Birrell c. 10, lines 39-41).

Dependent claims 4-6, 10-12 and 16-18 are allowable for at least their dependence upon allowable independent claims. Further, these claims recite patentably distinguishing features of their own. For example, claim 17 recites " storing, if the mail address extracted from the text of the E-mail received is not registered in the mail address book, a name of this unregistered mail address as a name unknown in the mail address book in a format of corresponding to the mail address." Dependent claims 16-18 were also amended to improve form.

In view of the foregoing, Applicants respectfully submit that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicants respectfully submit that this Amendment After Final Rejection clearly places the subject application in condition for allowance. This Amendment was not earlier presented, because Applicant believed that the prior Amendment placed the subject application in condition for allowance. Accordingly, entry of the instant Amendment as an earnest attempt to advance prosecution and reduce the number of issues, is requested under 37 C.F.R. § 1.116.

Lastly, on the Office Action Summary page of the June 5, 2003 Office Action, the Examiner asserts that the certified copy of the priority document was received in the National Stage Application from the International Bureau. It is respectfully submitted that the subject

application was filed under 35 U.S.C. §1.53(b) and that a certified copy of the priority document was submitted to the USPTO in accordance with the provisions of 37 CFR §1.55 concurrently with the filing of the subject application. Copies of the transmittal papers submitting the certified copy, the first page of the certified copy, and the date stamped postcard acknowledging receipt of same, are transmitted herewith.

The Examiner is respectfully requested to prepare and forward to the undersigned a Communication from the Examiner acknowledging our claim for priority based on Japanese Patent Application No. 11-302548 filed October 25, 1999.

## II. CONCLUSION.

Applicants believe that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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